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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,857	12/14/2001	John J. Giobbi	MD-3	7429
21186	7590	12/19/2005		
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402			EXAMINER WALSH, JOHN B	
			ART UNIT 2151	PAPER NUMBER

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/016,857	Applicant(s) GIOBBI, JOHN J.	
	Examiner John B. Walsh	Art Unit 2151	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on RCE of 10/27/2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-11 and 14-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-11 and 14-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/27/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, 9, 14-26 and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,804,825 to White et al. in view of U.S. Patent No. 6,104,334 to Allport further in view of U.S. Patent No. 6,667,684 to Waggamon et al.

As concerns claim 1, a centralized digital content distribution system for use in an establishment, comprising: a digital content server (12) for storing digital content acquired from a global computer network (16); a plurality of remote clients (14) located in rooms of the establishment and linked to the digital content server wherein the remote clients comprise two or more televisions (column 2, lines 58-60); and a portable remote control (52) for communicating with each of the remote clients and selecting the digital content stored in the digital content server.

As concerns claim 2, the system of claim 1, wherein the selected digital content is downloaded from the digital content server to one of the remote clients (column 11, lines 4-5, transmitted from server to client) and converted by the remote client to a playable format (converted from electrical signals into a playable format).

As concerns claim 3, the system of claim 2, wherein the playable format is compatible with a standard component (TV, column 1, line 25) connected to the remote client.

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As concerns claim 4, the system of claim 1, wherein the digital content server converts the selected digital content to a playable format compatible with a standard component coupled to the digital content server (column 2, lines 29-30, column 2, lines 63-64, decoder 62).

As concerns claim 5, the system of claim 1, wherein the remote clients are linked to the digital content server via a distribution hub (24, 20), and the remote clients are linked to the distribution hub by a backbone transmission network (column 3, line 33, various communication links which entail backbone transmission, column 10, lines 40-46).

As concerns claim 6, the system of claim 1, wherein the remote control includes means for establishing a first wireless transmission link (54) with each of the remote clients (similar TV's wherein the remote has it's IR code, remote will work for more than one tv).

As concerns claim 7, the system of claim 6, wherein the remote control is enabled to display (enabled to display on the tv) and select (column 4, lines 22-23, 30-38) the digital content available on the digital content server upon establishing the first wireless transmission link with one of the remote clients.

As concerns claim 9, the system of claim 6, wherein the first wireless transmission link is selected from a group consisting of a radio link and an infrared link (54, column 2, 62).

As concerns claim 14, the system of claim 1, wherein one or more of the remote clients are integrated into respective standard components (integrated with tv, column 3, lines 14-15).

As concerns claim 15, the system of claim 1, wherein the remote control is adapted to control the digital content server to acquire the digital content from the global computer network (remote control adapted to control menu on screen to access and control the database for downloading digital content).

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As concerns claim 16, the system of claim 16, wherein the remote control is adapted to sort and categorize (column 4, lines 22-23, when searching the database the remote control is adapted to sort and categorize) the digital content on the digital content server.

As concerns claim 17, the system of claim 1, wherein the digital content is formatted as a compact disc (CD), digital video disc (DVD), MP3, electronic book, or software (column 3, line 25, mp3 format).

As concerns claim 18, a centralized digital content distribution method for use in an establishment, comprising: storing digital content acquired from a global computer network at a digital content server (12); positioning a plurality of remote clients (14) in rooms of the establishment and linking the remote clients to the digital content server; and selecting the digital content stored at the digital content server by communicating with one of the remote clients with a remote control (52).

As concerns claim 19, the method of claim 18, further including downloading (column 11, lines 4-5, transmitted from server to client) the selected digital content from the digital content server to one of the remote clients and converting the downloaded digital content to a playable format (column 2, lines 29-30, column 2, lines 63-64, decoder 62).

As concerns claim 20, the method of claim 19, wherein the playable format is compatible with a standard component (TV, column 1, line 25) connected to the remote client.

As concerns claim 21, the method of claim 18, further including converting, at the digital content server, the selected digital content to a playable format compatible with a standard component coupled to the digital content server (column 2, lines 29-30, data converted into MPEG format compatible with the terminal 14).

As concerns claim 22, the method of claim 18, wherein the step of positioning a plurality of remote clients in rooms of the establishment and linking the remote clients to the digital content server includes linking the remote clients to the digital content server via a distribution hub (24, 20) and linking the remote clients to the distribution hub by a backbone transmission network (column 3, line 33; various communication links which entail backbone transmission; column 10, lines 40-46).

As concerns claim 23, the method of claim 18, further including establishing a first wireless transmission link (54) between the remote control and one of the remote clients.

As concerns claim 24, the method of claim 23, further including enabling the remote control to display (enabled to display on the tv) and select (column 4, lines 22-23 and 30-38) the digital content available on the digital content server upon establishing the first wireless transmission link between the remote control and one of the remote clients.

As concerns claim 26, the method of claim 23, wherein the first wireless transmission link is selected from a group consisting of a radio link and an infrared link (column 2, line 62).

As concerns claim 31, the method of claim 18, further including controlling the digital content server with the remote control to acquire the digital content from the global computer network (remote control adapted to control menu on screen to access and control the database for downloading digital content).

As concerns claim 32, the method of claim 31, wherein the step of controlling the digital content server with the remote control includes controlling the digital content server

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to sort and categorize (column 4, lines 22-23, when searching the database the remote control is adapted to sort and categorize) the digital content on the digital content server.

As concerns claim 33, a centralized digital content distribution system for use in an establishment, comprising: a digital content server (12) for storing digital content acquired from a global computer network and converting the digital content to a playable format (column 2, lines 29-30); a plurality of remote standard components (tv, column 3, lines 14-15) located in rooms of the establishment and linked to the digital content server; and a portable remote control (52) for communicating with each of the standard components and selecting the digital content to be converted by the digital content server to the playable format.

White et al. '825 do not explicitly disclose the remote control including a display.

Allport '334 teaches a remote control including a display (figure 3) for viewing downloaded content.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the remote control of White et al. '825 with a display, as taught by Allport '334, in order to provide a remote control that does not interfere with the tv or main viewing screen.

White et al. '825 as modified do not explicitly disclose encrypting and decrypting the digital content and a key code.

It is well known in the art to provide encryption, decryption and key codes for security, as taught by Waggamon et al. (abstract).

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the remote control of White et al. '825 as modified with encryption, decryption and key codes, as taught by Waggamon et al., in order to provide security and prevent unauthorized access of the digital content.

3. Claims 10, 11, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,804,825 to White et al. in view of U.S. Patent No. 6,104,334 to Allport and U.S. Patent No. 6,667,684 to Waggamon et al. as applied above, in view of U.S. Patent No. 6,401,059 to Shen et al.

White et al. '825 as modified do not explicitly disclose the remote control will control the standard components upon establishing a second wireless transmission link.

It is well known in the art for a single remote control to operate multiple devices, as taught by Shen et al. (figure 1B).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the remote control of White et al. '825 as modified with universal remote functionality, as taught by Shen et al. '059, in order to provide a more efficient system having fewer parts.

#### ***Response to Arguments***

4. Applicant's arguments filed October 27, 2005 have been fully considered but they are not persuasive.



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In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the digital content server is not imbedded) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant argues the content is obtained through a global computer network. White et al. '825 figure 2 disclose a satellite network, which is a global computer network, and content is obtained through the satellite network.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an Ethernet hub) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Elements 24 and 20 of White et al. '825 meet the limitations of a distribution hub.

The applicant argues that the remote clients are standard components. The term "standard component" is a relative term and the WebTV terminal is a "standard" component in the system it is used.

The applicant argues the remote control of White et al. '825 does not include a key code or an unlock code. White et al. '825 as modified, in view of Waggamon et al. '684 teach the key code and unlock code as claimed. Furthermore, Allport '334 teaches passwords and filters programmed into the remote control for controlling access to particular downloadable content (column 5, lines 38-41).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., digital content is converted to analog format) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As concerns the limitation of "the playable format is compatible with a standard component" is disclosed by White et al. '825 since the component receives the data in a particular format and "plays" the data it is therefore compatible. If it were not compatible it would not be "played".

As concerns the limitation of "the digital content server converts the selected digital content to a playable format", White et al. '825 discloses the server storing data as MPEG for on demand delivery (column 2, lines 27-29). The term "playable" is also a relative term that has been given its broadest reasonable interpretation.

As concerns claim 6, the TV's have a remote for that particular brand and the remote can operate another TV which is the same as the other TV. Since there is similar structures between them, similar functions can be performed. Also, Allport '334 teaches remote control for numerous devices (column 9, lines 20-26).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a remote for displaying the contents of the server on the remote display) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 7 does not recite that the content is displayed on the

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display of the remote control only that the remote control is enabled to display the content, wherein it is enabled to display the content on the display of the TV.

As concerns claim 9, the claim only requires selecting one from the group of a radio link and an infrared link. It does not require both a radio link and an infrared link. White et al. '825 disclose an infrared link (54 ; column 2, line 62).

As concerns claim 25, wherein displaying the content on a display of the remote control, White et al. '825 as modified, in view of Allport '334 teach displaying content on the remote control.

As concerns claim 32, White et al. '825 discloses sorting and categorizing content (column 4, lines 22-23). When searching the database the user is sorting and categorizing the content by the content they want to view until the sort and categorize the content down to a single selection for access.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Allport is capable of interacting with other data sources, which can include the networked environment of White et al. '825. One of ordinary skill in the art would have been motivated to modify the system of White et al. '825 in order to provide a remote control that is user-friendlier and functionality to the user for conveying content and overall use of the system.

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In the case of White et al. '825 as modified, in view of Waggamon et al., one of ordinary skill in the art would have been motivated to provide security and unauthorized access thus solving a particular problem.

The applicant should note that the examiner has not taken official notice. The references of Waggamon et al. and Shen et al. have been cited in the rejection for teaching particular claim limitations.

### *Conclusion*

5. This is a RCE of applicant's earlier Application No. 10/016,857. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

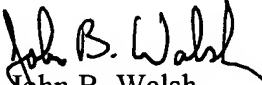
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Wednesday from 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
John B. Walsh  
Primary Examiner  
Art Unit 2151